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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,278	08/27/2001	Michelle Carey	0359.1-1-1CON	8119

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EXAMINER
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PEZZUTO, HELEN LEE

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/942,278

Applicant(s)

CAREY ET AL.

Examiner

Helen L. Pezzuto

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on papers filed on 10/24/05 and 11/21/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/254,339.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/05 has been entered.

***Response to Amendment***

Applicant's amendment to claim 34, the cancellation of claims 24-33, 35-37, and the submission of Terminal Disclaimer filed in the response on 10/25/05. As stated in the Advisory Action mailed on 11/10/05, applicant's reply has overcome the 112, 1<sup>st</sup>, and obviousness type double patenting rejections of record. Currently, claim 34 is pending in this application.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear from applicant's disclosure what the recited weight percent is based on? The total weight of the polymer or the total weight of the dispersion? Please clarify.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over AU 16642/76 or EP 0 466 409 A1 for the reasons of record and further in view of the following remarks.

AU 16642/76 discloses an anionically stabilized aqueous dispersion comprising 20-79.4 wt% of a hard monomer such as styrene, 20-79.4 wt% of C2-C8 alkyl acrylic acid ester, and 0.1 to 5 wt% (meth)acrylic acids, among other. The instant equation

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(I) is satisfied in the event that prior art dispersion contains 20 wt% styrene, 5 wt% (meth)acrylic acid, and 75 wt% of (meth)acrylates. Accordingly, it would have been obvious to one having ordinary skill in the art to select the recited monomers within in the amounts as taught in prior art disclosure, motivated by the reasonable expectation of success. The Tg of the resultant dispersion would be an inherent property because identical monomers and overlapping amounts of each are utilized, absent clear evidence that the respective dispersions do in fact differ.

EP 0 466 409 discloses an anionically stabilized aqueous dispersion comprising a blend of 20-60 wt% of a hard emulsion polymer having Tg greater than 20°C, and about 80-40 wt% of a soft emulsion polymer having Tg less than 20°C. Suitable monomer includes styrene, C1-C10 alkyl acrylates, and (meth)acrylic acid (page 4, lines 34-48). The resultant Tg of the emulsion blend overlaps with applicant's values (pages 9-10, Tables 4-5). Accordingly, since EP-409 discloses styrene, alkyl acrylate, and (meth)acrylic acids to be suitable monomers used to form aqueous dispersion having the instant Tg, this makes the selection of the monomers readily envisaged by one having ordinary skill in the art. Once the selection of the respective monomers are

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suggested, the determination of optimum or workable ranges to achieve the Tg as taught would involve only routine skill in the art. Thus, rendering obvious the present claim.

***Claim Rejections - 35 USC § 102/103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 34 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 562 730 A1 for the reasons of record and further in view of the following remarks.

EP-730 discloses an anionically stabilized aqueous dispersion with utility as coating material. Prior art discloses using less than about 15 wt% of (meth)acrylate

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monomers, less than about 25 wt% of styrene, and from 1 to about 100 wt%, most preferably 4-8 wt% of an ethylenically unsaturated carboxylic acid (i.e. (meth)acrylic acid).

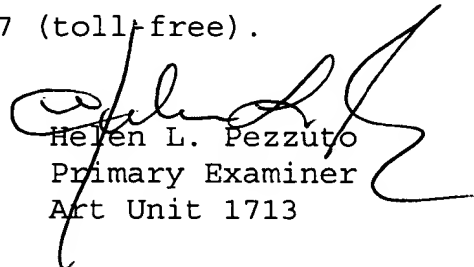
Prior art polymers 1-15 exemplified appear to satisfy applicant's equation (I). The examiner takes the position that the recited dispersion T<sub>g</sub> is considered inherent in the prior art dispersions because applicant uses the same monomers as prior art under the same conditions. The burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helen L. Pezzuto  
Primary Examiner  
Art Unit 1713

hlp